



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/542,814

09/26/2005

Bernhard Kreye

237397

8677

23548 7590 04/11/2008
LEYDIG VOIT & MAYER, LTD
700 THIRTEENTH ST. NW
SUITE 300
WASHINGTON, DC 20005-3960

EXAMINER

HERRING, BRENT W

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

04/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,814	KREYE, BERNHARD	
	Examiner	Art Unit	
	BRENT W. HERRING	3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-19 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 7 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on July 20, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Objections

2. Claims 1-27 are objected to because of the following informalities: while there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is" (or the equivalent). The claims should start with a preamble (i.e. a combination of a panel-shaped member and strip), followed by a transitional phrase (i.e. comprising), and concluded with a body to the claim (i.e. the panel-shaped member having...).

Appropriate correction is required.

3. Claims 1-27 are objected to because of the following informalities: where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). Appropriate correction is required.

4. Claim 6 is objected to because of the following informalities: the claim recites the limitation "the groove". There is insufficient antecedent bases for this limitation in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 25:

Applicant claims the combination of claim 1, "further comprising a second primer." Claim 1, however, reads "optionally comprising a primer." Therefore, the scope of the claim 25 is indeterminable.

Claims are examined as best understood.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 8-9, 12-18, 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kreye, U.S. Patent 6,086,695.

Regarding claim 1:

'695 discloses a panel-shaped member (1', see Fig. 3) and strip (11) combination, the member having a surface, the strip defining a region (internal area between interior walls 2a), a bonding material (2) the bonding material being disposed in the region secures the strip (11) to the surface of the member, the bonding material being covered by the strip and optionally comprising a primer applied to the surface of the member before the application thereto of the bonding material.

Regarding claim 2:

'695 discloses claim 1, wherein the bonding material (2) is polyurethane material (col. 1, Ins. 31-32).

Regarding claim 3:

'695 discloses claim 1, wherein the strip (11) comprises a surface in contact with the surface of the member (1', see Fig. 3, a surface portion of 11 being in contact), and the region is a channel (area defined by interior walls 2a)

in the material of the strip, the channel being connected to the surface of the strip which is in contact with the surface of the member.

Regarding claim 4

'695 discloses claim 3, wherein the channel comprises a narrowed mouth (wall surfaces 2a pinch towards each other creating a mouth) connecting the channel to the surface of the strip (11).

Regarding claim 5:

'695 discloses claim 4, wherein the channel comprises sides and inwardly directed wall portions (2a), the sides of the channel being connected to the narrowed mouth by the inwardly directed wall portions which extend to the mouth in directions inclined away from the said surface of the strip to provide a mechanical interlock between the material of the strip and the bonding material (see Fig. 3).

Regarding claim 6:

'695 discloses claim 3, wherein the bonding material is injected into the channel or groove from at least one end thereof.

Note that the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable

distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Regarding claim 8:

'695 discloses claim 1, wherein the surface of the panel-shaped member (1') is or includes an edge surface thereof (see Fig. 3, wherein adhesive 7 is attached to the surface of the panel).

Regarding claim 9:

'695 discloses claim 1, wherein the panel-shaped member comprises at least a partial surround, and the strip comprises a sealing portion (extended portion of 11 abutting body flange 12) extending therefrom capable of sealing against said at least partial surround of the panel-shaped member.

Regarding claim 12:

'695 discloses claim 1, wherein the panel-shaped member (1') is made of transparent or translucent material (col. 2, lns. 47-51).

Regarding claim 13:

'695 discloses claim 8, wherein the panel-shaped member is made of transparent or translucent material capable of use for a window and the surround (12) is part of the frame of a window opening.

Regarding claim 14:

'695 discloses a method of joining a panel-shaped member (1') to a strip (11). Comprising the step of forming a recessed region (area to the right of 2a, see Fig. 3) in a surface of the strip able to be secured to a surface of the member, and placing bonding material (2) in the region, securing the strip to the member with the bonding material being covered by the strip (11).

Regarding claim 15:

'695 discloses claim 14, wherein the bonding material is polyurethane material (col. 1, lns. 31-32).

Regarding claim 16:

'695 discloses claim 14, wherein the region is a channel in the material of the strip, the channel being connected to the surface of the strip which is in contact with the surface of the member (see Fig. 3).

Regarding claim 17:

'695 discloses claim 16, wherein the channel is connected to the surface of the strip by a narrowed mouth.

Regarding claim 18:

'695 discloses claim 17, wherein the sides of the channel are connected to the narrowed mouth by inwardly directed wall portions (2a) which extend to the mouth in directions inclined away from the said surface of the strip to provide a mechanical interlock between the material of the strip (11) and the bonding material (2).

Regarding claim 21:

'695 discloses a panel-shaped member (1') and sealing strip (11) combination, the member having a surface, the sealing strip being formed of a material, having a surface which is in contact with the surface of the member, and defining a region, a bonding material (2), the bonding material being disposed in the region to secure the sealing strip to the surface of the member, the bonding material being covered by the sealing strip (11), the region being a channel in the material of the sealing strip, the channel having a narrowed mouth (area between 2a) connecting the channel to the surface of the sealing strip.

Regarding claims 22- 24:

'695 discloses claims 1, 21, and 14 respectively, wherein the bonding material adheres to the strip (note that the strip is adhered to the bonding material by way of recesses 2a holding the strip).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3600

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreye ('695) as applied to claim 17 above, and further in view of Gold, U.S. Patent 5,470,422.

Regarding claim 19:

'695 discloses claim 17, but '695 does not expressly disclose the step of injecting the bonding material into the channel from at least one end thereof.

'422 discloses a method of joining a panel shaped member to a strip that includes the step of injecting the bonding material (30A, see Fig. 8) into a channel from at least one end thereof.

'695 and '422 are analogous art because they are from the same field of joining panels to strips.

At the time of the invention, it would have been obvious to inject the bonding material as taught by '422.

The motivation to combine would have been to ensure a strong bond between the strip and the panel.

Art Unit: 3600

12. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreye ('695) as applied to claims 1, 21, and 14, respectively, above, and further in view of Butler, U.S. Patent 3,879,241.

Regarding claims 25-27:

'695 discloses claims 1, 21, and 14 respectively, but '695 does not expressly disclose disposing a primer between the bonding material and the strip.

'241 discloses applying a primer to a base portion (16) and bonding material (20) prior to applying a strip (22).

'695 and '241 are analogous art because they are from the same field of strip and panel-member combinations for vehicles.

At the time of the invention, it would have been obvious to use the primer as taught by '241 between the bonding material and the strip of '695.

The motivation to combine would have been to increase bond strength between the strip and an adjacent surface (col. 4, Ins. 10-20).

13. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreye ('695) as applied to claim 9 above, in view of Tanaka et al., U.S. Patent 4,349,993.

Regarding claims 10 and 11:

'695 discloses claim 9, but '695 does not expressly disclose further comprising a decorative part and wherein the strip carries the decorative part; wherein the decorative part is clipped to the strip.

'993 discloses a panel - strip combination (11) with a decorative part (9) clipped to the strip (see Figs. 1-4).

'993 and '695 are analogous art because they are from the same field of panel-strip combinations for vehicles.

At the time of the invention, it would have been obvious to use the decorative part of '993 with the panel-strip combination of '695.

The motivation to combine would have been to provide an aesthetically pleasing outer lining on a vehicle.

Allowable Subject Matter

14. Claims 7 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT W. HERRING whose telephone number is

Art Unit: 3600

(571)270-3661. The examiner can normally be reached on Monday-Thursday, 8:00AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian E. Glessner can be reached on (571)272-6847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BWH/

bwh

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635

Application/Control Number: 10/542,814
Art Unit: 3600

Page 13